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TECHNOLOGY CENTER 3600

In re application of
Kenichi Miyazaki
Application No. 09/386,000
Filed: August 30, 1999
For: LARGE PRINTER

: **DECISION ON PETITION**
: **FOR SUPERVISORY REVIEW**
: **REGARDING REPLY BRIEF**
:

This is a response to applicant's petition filed August 14, 2006 requesting supervisory review of the examiner's refusal to enter the reply brief of October 11, 2005. The delay in answering the petition is regretted.

The Petition is **DENIED**.

37 CFR 41.41(a)(2) states:

A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

The appeal was remanded by the Board instructing the Examiner to consider and respond to applicant's reply brief filed October 11, 2005 regarding new evidence presented by the applicant, i.e. the User Manual for the OCE 9400. After remand and upon further review it was determined that the Reply Brief was not in compliance with 37 CFR 41.41(a)(2) because it included new evidence, i.e. the User Manual for the OCE 9400, that was not under consideration during prosecution and hence should not have been entered. The Board's decision was based on the belief that the Reply Brief was compliant. The examiner sent a communication dated November 4, 2005, indicating the Reply Brief had been entered and considered. The Board remanded the case March 15, 2006. Examiner sent a supplemental answer dated June 13, 2006 vacating the previous communication dated November 4, 2005, denying entry of the reply brief because it presented new evidence. Applicant filed a petition for entry of the Reply Brief August 14, 2006.

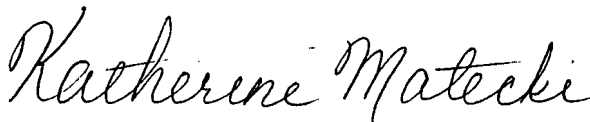
Applicant argues the reply brief should be entered because applicant's first opportunity to respond to the details of the examiner's rejection on the OCE 9400

device was in the Reply Brief of October 11, 2005. However, applicant had the opportunity to respond to the rejection in his response dated November 1, 2004. Instead applicant failed to comply with 37 CFR 1.111(b) because the arguments presented with regard to the OCE 9400 rejection merely amounted to a general allegation that the claims defined a patentable invention without specifically pointing out how the language of the claims patentably distinguished them from the reference cited by the examiner. Applicant had the opportunity then when first cited the OCE 9400 device to do an Internet search to find the User Manual. Applicant instead made a general allegation of patentability and argued the date of the reference cited, arguing that the reference was not prior art (see Applicant Arguments/Remarks dated 11/1/2004: pages 15-16). For the forgoing reasons the reply brief will not be entered.

Applicant further requests that in the alternative the Reply Brief should be treated as a request to reopen prosecution, for consideration of the OCE 9400 manual, under 37 C.F.R. § 41.39(b)(1) and (2), if the U.S. Patent and Trademark Office (USPTO) believes the supplemental answer contains a new ground of rejection. However, the position of the USPTO is the same as the applicant's regarding the supplemental answer, that it does not contain new grounds of rejection. Hence, prosecution will not be reopened.

Accordingly, the reply brief will not be entered and prosecution will not be reopened and the case will be forwarded to the Board of Patent Appeals and Interferences for review on appeal.

Inquiries related to this decision may be directed to Supervisory Patent Examiner Gene O. Crawford at (571) 272-6911.

A handwritten signature in cursive script that reads "Katherine Matecki".

Katherine Matecki
Director
Technology Center 3600

[KD/GC: 4/23/07]